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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,249	03/17/2004	Ralf Mauritz	21718 US-as	5270
67491 7590 11/09/2010 DINSMORE & SHOHL, LLP FIFTH THIRD CENTER ONE SOUTH MAIN STREET SUITE 1300 DAYTON, OH 45402				
EXAMINER				
LIU, SUE XU				
ART UNIT		PAPER NUMBER		
1639				
MAIL DATE		DELIVERY MODE		
11/09/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/802,249

**Applicant(s)**

MAURITZ ET AL.

**Examiner**

SUE LIU

**Art Unit**

1639

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 13 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 13 and 15-22 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

**Please note the change of examiner for this application.** (Please see the Conclusion paragraph for information on any future correspondence.)

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/2010 has been entered.

#### ***Claim Status***

1. Claims 4-12, 14 and 23-26 have been cancelled as filed on 10/12/2010.  
Claims 1-3, 13, and 15-22 are currently pending.  
Claims 1-3, 13 and 15-22 are being examined in this application.

#### ***Election/Restrictions***

2. Applicant's election without traverse of Group I (Claims 1-22) in the reply filed on 10/18/06 is as previously acknowledged.
3. Applicant's election without traverse of the following species:  
A.) nucleic acids for the biopolymers;  
B.) fluorescent groups, specifically, stilbene, as the detectable protecting groups;

C.) Compound (f) in Figure 5 as the core structure;

in the reply filed on 10/18/06 and 3/6/07 is as previously acknowledged.

***Priority***

4. This application claims foreign priority to EPO 03006098.2 (3/19/03).
5. Receipt is as previously acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Objection(s) / Rejection(s) Withdrawn***

6. In light of applicants' amendments to the claims and supporting arguments, the objection against Claim 3 in the previous office action is withdrawn.
7. In light of applicants' amendments to the claims and supporting arguments, the following claim rejection has been withdrawn:

A.) Claims 1-3, 13 and 15-22 are rejected under **35 U.S.C. 103(a)** as being unpatentable over **McGall** et al (US 6,238,862; 05/29/2001), **Wagner** et al (Helvetica Chimica Acta. Vol. 80: 200-212. 1997; cited in IDS filed on 9/22/04), in view of **Hobbs** et al (5,151,507; 9/29/1992; cited previously), **Chen** et al (Journal of Organic Chemistry. Vol. 66: 1725-1732; 2001; cited previously) and **Agris** (PGPUB 20020045167; 4/18/2002; cited previously).

***New Claim Objection(s) / Rejection(s)***

***Claim Objections***

2. Claim 1 objected to because of the following informalities:

**A.)** in step (d) of claim 1, the term “the” is missing after the phrase “repeating steps (b) and (c) until” (i.e. the phrase should recite “repeating steps (b) and (c) until the detectable groups...”

**B.)** in the last line of claim 1, the term “the” is missing before the phrase “synthesized biopolymer species...” (i.e. the phrase should recite “...and wherein the synthesized biopolymer species are...”)

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 13 and 15-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite “wherein synthesized biopolymer species are not consumed or eliminated by practice of the method” as filed on 12/18/09. However, the instant

specification does not appear to provide support for the claimed method step as recited. In particular, the instant specification/claims as originally filed does not provide support for the recitation that all the synthesized biopolymer species are neither “consumed” nor “eliminated”.

If Applicant believes this rejection is in error, applicant must disclose where in the specification support for the entire scope of the amendment(s) and/or new claims can be found. As a result, Claim1 and its dependent claims represent new matter.

#### *Future Communications*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Liu whose telephone number is 571-272-5539. The examiner can normally be reached on M-F 9am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Joanne Hama can be reached at 571-272-2911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sue Liu/  
Primary Examiner, AU 1639  
11/4/2010

